

REMARKS/ARGUMENTS

In the Office Action, the Examiner has again rejected claims 7, 10, and 11 as being anticipated by Liebscher and claims 4-11 as being obvious over Bartneck as modified by Liebscher.

Applicant will first specifically address the Examiner's responses to Applicant's arguments filed in the Amendment of February 20, 2009, as provided in the "Response to Arguments" section of the Office Action and then address the specific rejections in this context.

1. Liebscher's part 15 vs. Applicant's inner sole

The Examiner argues that Liebscher's part 15 cannot be distinguished from the inner sole 5 of the present invention. Applicant respectfully disagrees.

The inner sole 5 extends over the complete width of the shoe sole 4, which consists of the insole 3 and the sole tread 2. This can be clearly seen in Figure 1 of Applicant's application and is disclosed at least at para. 0013 of Applicant's specification. Accordingly, the insole 3 is covered towards the top by the inner sole 5.

Liebscher's part 15 is a welt with a portion 14 which does not cover the insole completely, but rather, forms a connection between the upper and an inner sole.

However, to more-particularly structurally claim Applicant's inner sole 5, and as suggested by the Examiner in the Office Action, Applicant has amended independent claims 4, 7, and 16 to claim that the inner sole completely covers a top of an insole of the shoe. As such, Applicant respectfully submits that Applicant's inner sole is now even further structurally distinguishable from Liebscher's part 15, which merely forms a connection between the upper and the inner sole.

2. Pressing the upper into the insole

Regarding the Examiner's argument that Applicant argues that Liebscher does not teach "pressing the upper into the insole" (emphasis added), Applicant respectfully submits that this is not what Applicant argues. Applicant's argument is that the upper and the inner sole 5 (and thus, not the insole 3, as argued by the Examiner) are pressed together so that the edge of the upper 7 is pressed into the inner sole 5 (See Figure 2 of Applicant's application).

However, even if the welt of Liebscher can be interpreted as an "inner sole", it must be noted that the welt portion 14 and the upper 1 are pressed onto each other, but, the upper is not pressed into the welt, as claimed by Applicant. According to Figure 5 of Liebscher, the mold last 9 provides a step in which the edge of the upper 1 rests so that it is impossible for the edge of the upper 1 to be pressed into the welt portion 14. According to Figure 4, there is a step in the transition of the upper 1 to the welt portion 14. The pressure is obviously not high enough to press the edge into the welt portion 14. Therefore, in both cases, the edge of the upper 1 would have to be provided with a chamfer to avoid harming the foot of a person wearing the shoe.

3. Fixed internally

Applicant respectfully submits that the term "fixed internally" is clearly defined in para. 0014 of Applicant's specification, in which it is stated that the edge of the upper is not folded outwardly, but runs on the inner side of the inner sole 5. In order to run on the inner side of the inner sole, the upper 7 has to be folded inwardly and then fixed to the inner sole. This can also be clearly seen in the Figures of Applicant's application.

With this definition of the term "fixed internally", the upper 2 of Bartneck is not fixed internally to the inner sole 14 because the edge of the upper 2 is folded outwardly and not inwardly.

Applicant respectfully acknowledges that the Examiner may broadly interpret claim terms, but not in the circumstance where Applicant has

specifically provided a definition for the claim term “fixed internally” in Applicant’s specification.

4. Adjacent to the fillet

Applicant respectfully submits that the meaning of the phrase “adjacent to the fillet” is that the edges of the inner sole 5 and of the upper 7 form layers on the fillet 9, whereby the upper lies flush on the fillet and is therefore adjacent to the fillet. Due to this arrangement, the inner sole 5 is pressed, on expanding of the insole material, against one side of the upper, the other side of which is pressed against the fillet. Figure 2 of Applicant’s application clearly shows that the edge of the inner sole 5 and of the upper 7 form layers arranged on the fillet and do not stand off therefrom as in Bartneck.

However, in order to more-particularly claim the relationship between the edge of the upper piece and the fillet, Applicant has amended independent claims 4 and 16 to now more-particularly claim that the shoe base material presses the inner sole 5 against the edge 12 of the upper piece 7 that lies against the fillet 9. Applicant respectfully submits that this feature of Applicant’s invention can be clearly seen in Figure 1 of Applicant’s application.

Thus, Applicant respectfully submits that even if the Examiner can broadly interpret Bartneck such that Bartneck discloses that the inner sole is pressed against the edge of the upper that is “adjacent” to the fillet, that Bartneck does not disclose this more-particularly claimed feature where the edge of the upper lies against the fillet. In Bartneck, the edge of the upper is merely in the vicinity of the fillet, but does not lie against the fillet. According to Bartneck, since the edge of the upper which is subjected to the pressure stands off from the fillet, the edge may be in the vicinity of the fillet, or “adjacent” to the fillet, but it does not lie against the fillet. Therefore, Applicant respectfully submits that Bartneck does not disclose this feature of Applicant’s invention as now more-particularly claimed.

5. Inverting the role of the upper and inner sole

Applicant again respectfully submits that an inversion of the roles of the inner sole and the upper of Bartneck does not lead to Applicant's claimed invention where the upper is folded inwardly. Applicant's extensive arguments regarding this argument by the Examiner can be found in the Amendment of February 20th.

6. Obvious variation of Bartneck's principle of operation

Applicant respectfully submits that the Examiner fails to argue what Bartneck's principle of operation is. As such, the Examiner's argument that the Examiner's modification of Bartneck does not represent a departure from Bartneck's principle of operation, but rather, is only an obvious variation of the principle of operation, is unfounded. The Examiner only argues that the intended purpose of Bartneck is to provide a simplified method and apparatus of direct molding of an upper to a shoe sole. However, even if this is the intended purpose of Bartneck, this broad purpose can be met by different principles of operation. Applicant again respectfully submits that the Examiner's argued modification of Bartneck changes the principle of operation of Bartneck, even if the modification meets the intended purpose of Bartneck. Applicant respectfully submits that if the argued modification changes the principle of operation of the reference, the modification is improper, regardless of whether or not the modification still meets the intended purpose of the reference. M.P.E.P. ¶ 2143.01. Applicant also respectfully submits that an argued modification that renders the prior art unsatisfactory for its intended purpose is also impermissible. However, whether a modification changes the principle of operation of a reference or renders it unsuitable for its intended purpose, both of which are impermissible, these modifications are separate analyses. Applicant respectfully submits that the Examiner has mixed these separate analyses.

Furthermore, Bartneck clearly teaches that the margin of the upper rests on the mold edges. There is not even a slight hint that the inner sole (the

“socklining” in Bartneck’s terms) can be secured between the upper mold and the lower mold.

In addition, according to feature (e) of claim 1 of Bartneck, the resin in the lower mold is cured to the underside of the socklining and the upper. If the role of the socklining and the upper were to be inverted, the resin could not reach the upper. The upper would only be fastened to the socklining by stitching which would have to be extremely strong to withstand the load on the upper while walking. According to Bartneck, the upper is stitched to the socklining and, in addition, is glued to the sole so that the connection is very strong. The arrangement of the upper and the socklining is based on technical considerations, and thus, is part of Bartneck’s principle of operation.

Therefore, Applicant respectfully submits that inverting the roles of the upper and of the inner sole would change the principle of operation of Bartneck.

7. Examiner’s rejection of independent claim 7 as being anticipated by Liebscher

The Examiner has again rejected claims 7, 10 and 11 as being anticipated by Liebscher.

Independent claim 7 particularly claims that an edge of an inner sole is placed on an edge of a casting mold. The Examiner appears to state that this feature of claim 7 can be seen in Figure 4 of Liebscher. However, according to Fig. 4 of Liebscher, a lasting (inner) margin 10 of a welt partially reaches a last, wherein the outer margin (outward extension 15) is placed on the edge of a casting mold 25. Since this welt cannot now be interpreted to be Applicant’s claimed inner sole, which has been more-particularly claimed in this Amendment as completely covering a top of an insole of the shoe, even if this welt is placed on an edge of the casting mold, the welt on the casting mold cannot disclose Applicant’s now more-particularly claimed inner sole that is placed on the edge of the casting mold.

Further, Applicant respectfully submits that Liebscher also does not disclose the feature of claim 7 of pressing the edge of the upper shoe piece into the inner side of the inner sole. Please see Applicant's detailed arguments in para. 2 above.

Therefore, Applicant respectfully submits that amended independent claim 7, and dependent claims 8 – 11 which depend therefrom, are allowable over Liebscher for at least these reasons.

8. Examiner's rejection of independent claims 4, 7, and 16 as being obvious over Bartneck and Liebscher

Further regarding the Examiner's rejection of independent claims 4, 7 and 11 as being obvious over Bartneck in view of Liebscher, the Examiner argues that the only difference between Bartneck and the subject matter of the claims is that the edge of the inner sole is not placed on the edge of the casting mold. Applicant again respectfully submits that this feature is not the only difference between Applicant's invention and Bartneck.

As discussed above, independent claims 4 and 16 further claim the features where the upper is fixed internally to the inner sole and the shoe base material presses the inner sole against an edge of the upper that lies against the fillet. Please see paras. 3 and 4 above for Applicant's detailed arguments regarding these features.

Further regarding claims 4, 7, and 11, Applicant respectfully traverses the Examiner's arguments that it would have been obvious for aesthetic reasons to invert the roles of the upper piece and the inner sole. Applicants arguments can be found at least at paras. 5 and 6 above.

Further, Applicant respectfully submits that the object of the Liebscher invention is to achieve a sole which looks bigger than it really is. However, to achieve this with a shoe according to Bartneck, there would be no motivation to alter the roles of the upper and the inner sole. It is merely necessary to arrange

the seam between the upper and the inner sole at a higher level with regard to the last and to arrange the last deeper in the lower mold.

Therefore, for making the sole look bigger than it is, there would be no motivation to invert the roles of the upper and the inner sole in Bartneck, as argued by the Examiner. This would have no purpose in Bartneck. In Bartneck, if any modification is to be made, it would only be related to arranging the levels of the upper and the inner sole with respect to the lower mold.

Furthermore, according to Bartneck, the outer edge of the upper is placed on the edge of the lower mold not only for aesthetic reasons, but also for reasons of durability. Please see also Applicant's arguments at para. 6 above.

Regarding the Examiner's rejection of dependent claim 9 based on Bartneck, the Examiner argues that Bartneck, (Fig. 3, part 14) discloses an indentation on the inner side of the inner sole. Part 14 is the socklining which the Examiner corresponds to the inner sole of the present invention. The socklining lies flush against the bottom of the last. Therefore, Applicant respectfully submits that in Bartneck no indentation of the socklining (inner sole) can occur. Applicant respectfully submits that dependent claim 9 is allowable for at least this additional reason.

Regarding the Examiner's rejection of dependent claim 10 based on Bartneck, as discussed above, in Bartneck the edges of the upper and of the inner sole stand off from the last and run parallel. Therefore, both bend outwardly; thus, there is no alignment, as defined in para. 2 above. According to the present invention, the upper is bent inwardly and runs antiparallel to the inner sole. When the inner sole is pressed against the edge of the upper, an indentation is formed in the inner sole in which the edge of the upper rests, whereby the inner surfaces of the upper and of the inner sole lie in a plane (this means they are aligned). Such a situation is shown in Figure 2 of Applicant's application and cannot be found in Bartneck.

Applicant also respectfully submits that such a feature also cannot be found in Liebscher. In Figure 4 of Liebscher, it is clearly shown that there is a

step between the upper and the welt so that the end on the upper forms a sharp edge which can scratch or jab the foot of the wearer.

The effect of this alignment of Applicant's invention can be seen in Figure 2 of Applicant's application, which shows that the inner surfaces lie in a plane so that no harm can be done to the foot of a person wearing the shoe. Therefore, Applicant respectfully submits that dependent claim 10 is allowable over both of the Examiner's bases of rejection of dependent claim 10, i.e., Bartneck and Liebscher.

Since the present Office Action is a "Final" Action, Applicant is filing a Request for Continued Examination concurrently with the filing of this Amendment.

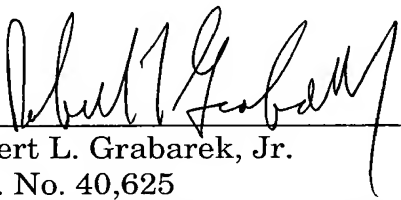
Applicant respectfully submits that the application is now in condition for allowance. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

As provided for above, this paper includes a Petition for an Extension of Time sufficient to effect a timely response. Please charge any deficiency in fees, or credit any overpayment of fees, to Deposit Account No. 05-1323 (Docket No. 056310.57444US).

Respectfully submitted,

CROWELL & MORING LLP

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By 
Robert L. Grabarek, Jr.
Reg. No. 40,625
Tel.: (949) 263-8400 (Pacific Coast)

Intellectual Property Group
P.O. Box 14300
Washington, D.C. 20044-4300

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